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10/720,005

11/21/2003

Matthew Howard Fronk

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EXAMINER

DOVE, TRACY MAE

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/720,005  
Filing Date: November 21, 2003  
Appellant(s): FRONK ET AL.

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/20/08 appealing from the Office action mailed 5/1/08.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

MPEP 1412.03, section 1.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 9-172 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. Each of claims 9-172 are broader

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than the claims of the patent. Note claim 80 does not require the resistivity limitation of the patent claims. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

### **(10) Response to Argument**

A reissue application for U.S. Patent 6,372,376 (issued 4/16/02) was filed on 11/21/03. The declaration does not state the reissue application is a broadening reissue (see page 1 of the declaration). Applicant does not make a statement that the reissue is a broadening reissue until the second preliminary amendment filed on 10/20/04, which is more than 2 years after the patent has issued. 35 U.S.C. 251 recites "no reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent." Since the intent to broaden was not presented within two years of the patent date, a broadening reissue application cannot be granted by the Examiner.

Reissue statute requires that proposals to broaden a patented invention must be brought to public notice within two years of patent issuance. The interested public is entitled to rely on the absence of a broadening reissue application within two years of grant of the original patent. Since the broadened claims were first filed more than two years after patent grant and no clear intent to file a broadening reissue was present in the declaration, the Examiner requests the 35 USC 251 rejection be upheld by the Board.

Applicant stated in the declaration that the reissue was being filed to correct an "inadvertent error in claim 1. The word "no" should have been in the claim when the limitations of claim 12 were incorporated into claim 1 by amendment (Paper No. 4) dated June 25, 2001 during the prosecution of United States Patent No. 6,372,376". This statement does not provide the public notice of a broadening reissue within two years of the grant of the original patent. There is no clear intent to file a broadening reissue application present in the declaration.

Applicant argues the statement "by reason of a patentee claiming more or less than he had a right to claim in the patent" is clearly a statement of intent to file a broadening reissue application. However, due to the "inadvertent error" described by Applicant in the declaration, Applicant has claimed more than he had a right to claim in the patent because "a resistivity greater than about 50 ohm-cm" is not supported by the original specification. In any case, the statement "more or less" does not establish a clear intent to file a broadening reissue application because if Applicant claimed more than he had a right to claim, the claims would appear to be necessarily narrowed in the reissue application. The declaration provides a section that asks Applicant to state with an explanation if the reissue is a broadening reissue. Applicant provides no statement of intent to file a broadening reissue in this section and only states "the amendment to claim 1 corrected an inadvertent error in claim 1".

Applicant asserts the Examiner has provided no authority for taking the position that a broadening reissue application must include a claim that is broader than every claim in the issued patent. However, the Examiner has stated MPEP 1412.03, section I,

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sets forth that a broadened reissue claim is a claim which enlarges the scope of the claims of the patent, i.e., a claim which is greater in scope than each and every claim of the original patent. It appears that patent claim 1 is more narrow than patent claim 8.

Note for example that patent claim 1 requires the inclusion of graphite particles and specific electrically conductive particles which are not required in patent claim 8.

Claim 1, as amended by applicant in the reissue application, does not appear to be greater in scope than each and every claim of the original patent. Thus, there does not appear to be any intent to broaden the claims within two years of the patent grant.

Applicant asserts the amendment filed on November 21, 2003 intended to broaden independent claim 1 because the addition of the word “no” changed the resistivity range of the mixture. However, the limitation “a resistivity no greater than about 50 ohm-cm” is present in patent claim 8. Claim 1, as amended on 11/21/03, is not broader than patent claim 8.

Applicant submits that patent claim 8 includes the limitation directed to the “substrate comprising a first acid-soluble metal underlying a second acid-insoluble, passivating layer susceptible to oxidation in said environment”, which is not found as a limitation in independent claim 1. Therefore, Applicant asserts that reissue claim 1 is broader than patent claim 8 in at least one respect. However, it appears that patent claim 1 is more narrow than patent claim 8. Note for example that patent claim 1 requires the inclusion of graphite particles and specific electrically conductive particles which are not required in patent claim 8. MPEP 1412.03, section I, sets forth that a broadened reissue claim is a claim which enlarges the scope of the claims of the patent,

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i.e., a claim which is greater in scope than each and every claim of the original patent.

Claim 1, as amended by applicant in the reissue application, does not appear to be greater in scope than each and every claim of the original patent. Thus, there does not appear to be any intent to broaden the claims within two years of the patent grant.

Examiner requests the Board affirm the rejection of claims 9-172 under 35 USC 251 because no clear intent to file a broadening reissue was presented within two years of the grant of the original patent. Instead the reissue was filed to correct an "inadvertent error" that occurred when original patent application claims 1 and 4 were rewritten as new patent application claim 12. New patent application claim 12 was renumbered as original patent claim 1.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/TRACY DOVE/

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/William Krynski/

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